

**REMARKS**

The outstanding issues in the instant application are as follows:

- Claims 13 – 16 are rejected under 35 U.S.C. § 112, second paragraph; and
- Claims 1 – 21 are rejected under 35 U.S.C. § 103(a).

Applicant hereby traverses the outstanding rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Applicant has canceled claim 13 without prejudice. Claims 1 – 12 and 14 – 21, thus, remain pending in this application after entry of the present amendment.

***Rejections Under 35 U.S.C. § 112, Second Paragraph***

The Examiner rejected claims 13 – 16 as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Specifically, the Examiner pointed out that claims 13 – 16, which are written in method format, depend from claim 6, which is an apparatus claim. In response, Applicant has canceled claim 13 and amended claims 14 – 16 to reflect dependency from the method claim of claim 1. No new matter was added. As each element of indefiniteness cited by the Examiner has been addressed with a corresponding amendment, Applicant respectfully requests the rejection of claims 14 – 16 under 35 U.S.C. § 112, second paragraph be withdrawn.

***Rejections Under 35 U.S.C. § 103(a)***

Claims 1 – 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,103,265 to Bell, et al. (hereinafter *Bell*) in view of elements claimed as being well-known in the art at the time the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P.

§2143. Applicant asserts that the rejection does not provide an adequate suggestion or motivation for modifying *Bell* as suggested by the Examiner.

The Office Action Does Not Provide the Requisite Motivation

Claim 1 was amended to require, “disabling highlighting of said near portions and said far portions when a user-selectable option is selected.” Claim 6 was amended to require, “disabling said highlighting of said near and said far portions.” Support for these amendments can be found in the Specification, at least, at page 7, lns 6 – 7. No new matter was added. Claim 17 requires, “a disabling feature which disables highlighting when selected by a user.” The Examiner admits that *Bell* does not teach disabling the highlighting of the near and far portions when a user-selectable option is selected. The Examiner attempts to cure this deficiency by asserting common knowledge. The motivation for making the combination was presented as follows:

It would have obvious to one of ordinary skill in the art at the time of the invention to supply a user selectable option to disable the highlighting of the near portions and the far portions (in essence, and [sic] on/off button) to the focus highlighting method of Bell et al. Office Action, p. 3.

No valid suggestion has been made as to why the addition of a user-selectable option to disable the highlighting is desirable. The Examiner stated:

The focus highlighting method set forth by Bell et al. is similar to other camera functions such as red-eye reduction, data imprinting ..., autofocus, etc. However, as is sometimes the case the user may not require the aid because the function is not necessary at the instant time or the user is an experienced photographer (an experienced photographer would be able to tell what objects are in focus without the aid of highlighting. Office Action, p. 3.

However, these statements are inapposite with the teachings in *Bell*.

First, *Bell* requires a camera with autofocus. The Field of the Invention stated in *Bell* “relates generally to a photographic camera with autofocus.” Thus, asserting that a camera manufactured according to the disclosure of *Bell* would include an on/off switch for the autofocus feature teaches away from the specifically enumerated *Bell* invention. Because the *Bell* subject highlighting is connected directly with the autofocus feature, as disclosed in the

patent, it would be improper to modify *Bell* to include a user-selectable option to disable the highlighting.

Furthermore, *Bell* states that

... [I]t is usually necessary for the operator to determine whether the depth of field is sufficient by observing that the subjects of interest are not blurred in the viewfinder. However, this is a difficult task since, in a depth of field preview mode, the image may be generally dim and thus hard to clearly observe and especially difficult to determine the amount of blur of the subject as compared to the background. This, it is often difficult for operators to determine that the proper subjects are in focus. Col. 1, lns 41 – 50.

Thus, *Bell* characterizes the problems with the prior art, and therefore the applicability of the highlighting invention, as transcending the skill of the user. A skilled photographer would not necessarily have better eyesight or the natural ability to magnify the light of the “generally dim and thus hard to clearly observe” image in the viewfinder. The Examiner’s asserted motivation for modifying *Bell* to include an on/off switch for the highlighting is specifically rejected by *Bell*’s own teachings. Therefore, the rejection of claims 1 and 6, as amended, and 17 should be withdrawn.

Claims 2 – 5, 7 – 16, and 18 – 21 depend from claims 1 and 6, as amended, and 17 respectively, and thus inherit all limitations of those respective base claims. Thus, Applicant respectfully asserts that, for the above reason, claims 1 – 12 and 14 – 21 are patentable over the 35 U.S.C. § 103 rejection of record and respectfully request the Examiner to with these rejections.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness. M.P.E.P. § 2143.01. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is

improper, as the recited motivation fails to establish an appropriate desirability for making the modification.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10005759-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256033597US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: September 18, 2003

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Respectfully submitted,

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